

REMARKS

In the Office Action dated August 1, 2005, the Examiner rejected claims 1-10.

Following entry of the present amendment, claims 1-10 are pending. In the present amendment, Applicants amend independent claims 1 and 6, and dependent claim 8 to conform with conventional English language and grammar. Applicants also amend the title of the application to conform with conventional English language and grammar, and to be consistent with the original Declaration. No new matter is added by the present amendments.

I. Rejection of Claims 1-10 Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Office Action at page 2.

Solely to facilitate prosecution, Applicants have amended the claims to conform with conventional English language and grammar. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 112.

II. Rejection of Claims 1-10 Under 35 U.S.C. § 103

The Examiner rejected claims 1-10 under 35 U.S.C. § 103 as allegedly being unpatentable over Glaze, et al. (U.S. Patent No. 5,593,888) in view of “Gardening Basics Choosing a Soil Amendment.” Office Action at page 2. The Examiner cites Glaze as allegedly teaching “the method of purifying contaminated soil comprising adding a soil improving material (unspecified “other amendments” column 15, line 40); and mixing the soil by agitation while

adding microbes.” Office Action at page 2. The Examiner cites “Gardening Series” as teaching “that it is advantageous to add perlite to clay soils to improve their permeability,” and stated that “Applicant’s [sic] specification teaches that perlite inherently meets the claimed properties.”

Office Action at page 3. Further, the Examiner stated that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Glaze process to have included perlite as the ‘other amendment’, in order to improve soil permeability, for example; thus resulting in the claimed properties called for in claim 1.” Office Action at page 3.

Applicants respectfully traverse because the Examiner has not set forth a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. M.P.E.P. § 2142-43 at 2100-128 – 2100-132. Neither of the cited references, either singly or in combination, teach or suggest all the claim limitations, particularly adding a soil-improving material to purify contaminated soil by microorganisms. *See* Claims 1 and 6.

Further, the references must be considered in their entirety, as a whole; the examiner cannot pick and choose disclosures from the references. M.P.E.P. § 2141.02 at 2100-124 – 2100-127; *see also In re Inland Steel*, 265 F.3d 1354, 1361 (Fed. Cir. 2001). When considered in its entirety, contrary to the Examiner’s reliance on Glaze, Glaze does not teach the method of purifying contaminated soil using microorganisms. Indeed, when read as a whole, Glaze’s teaching of adding “other amendments” is only in conjunction with an apparatus for accelerated bioremediation (column 3, lines 51-60) that is used for generating an air stream in the soil (column 3, lines 55-59, and column 4, lines 53-65). Any addition of “other amendments” (column 15, line 40) is done further to the use of the apparatus. *See, e.g.*, adding wood chips to

configure the soil pile dimensions in conjunction with the use of the machine (column 11, lines 34-62).

In addition, an obviousness rejection may not be based on inherency, since that which may be inherent is not necessarily known. M.P.E.P. § 2141.02 at 2100-126 (“Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established.”); *see also In re Rejckaert*, 9 F.3d 1531, 1534 (Fed Cir. 1993). Therefore, the Examiner’s assertion that “perlite inherently meets the claimed properties” (Office Action at page 3) cannot be used to support an obviousness rejection.

Furthermore, the Examiner must provide some motivation or suggestion to modify or combine the cited references. M.P.E.P. § 2142-43 at 2100-128 – 2100-132 (“[T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”). The Examiner has failed to meet this burden as well. As discussed above, Glaze does not teach the addition of soil-improving material to contaminated soil for bioremediation purposes; Glaze only teaches the method of using an apparatus to accelerate bioremediation by creating an air stream. Column 15, lines 39-41. There is no motivation to combine Glaze with “Gardening Series” because Glaze in no way suggests that materials be added to soil without the use of an apparatus. In fact, it is the Applicants’ own disclosure that provides such a suggestion or motivation, and it is well established that the Examiner may not rely on the Applicant’s own disclosure to supply the necessary motivation. M.P.E.P. § 2143 at 2100-128 and 2100-129.

Finally, the Examiner has not indicated any reasonable expectation of success, the third element of a *prima facie* case of obviousness. M.P.E.P. § 2142 at 2100-128, § 2143 at 2100-129 and § 2143.02 at 2100-132.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. In the event that the Examiner does not find the claims allowable, Applicants request that the Examiner contact the undersigned at (650) 849-6607 to set up an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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